



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,313	05/09/2001	Larry Harris	41872-249694	4713

7590 03/09/2005

J. Michael Boggs
Kilpatrick Stockton LLP
1001 West Fourth Street
Winston-Salem, NC 27101-2400

EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,313

Applicant(s)

HARRIS ET AL.

Examiner

Elizabeth M. Cole

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-55, 57, 60-63 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-46, 49, 5-55, 57, 60-63, 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/2/04 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 44-46, 49, 5-55, 57, 60-63, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 581,274 to Kamata et al in view of EP 436,729 to Yamato et al as set forth in paragraph 2 of the previous action.
4. The Declaration under 37 CFR 1.132 filed 12/2/04 is insufficient to overcome the rejection of claims 44-46, 49, 5-55, 57, 60-63, 65 based upon over EP 581,274 to Kamata et al in view of EP 436,729 to Yamato as set forth in the last Office action because: the showing fails to set forth a sufficient number of tests and fails to show that the difference between the samples tested is significantly significant and consistent from test to test. Also, the amounts of the various components is not specified and it is not shown that the differences would be consistent regardless of relative amounts, material used, etc. Therefore, the rejection is maintained.
5. Applicant's arguments filed 12/2/04 have been fully considered but they are not persuasive. Applicant argues that the claimed product has a greater distribution and penetration of the microcapsules on and through the material than a product made by

Art Unit: 1771

the process of the prior art. However, the declaration states that there was a greater number of microcapsules, but does not provide data regarding the distribution and penetration of the microcapsules, other than to say that it is significantly greater. However, it is not clear how this measurement was made, or what the values for the inventive sample and the prior art sample were. Further, the declaration does not set forth where the microcapsules which were observed on both the prior art fabric and the inventive fabric were located, other than to say that the inventive fabric had microcapsules had greater distribution and penetration of microcapsules, although this seems to be an important feature of the invention. It would be helpful, therefore, for Applicant to show that the difference in the quantity of the microcapsules is significantly significant, that the result can be replicated reliably, and to compare the penetration of the two samples quantitatively and again show that the result can be replicated reliably and is significantly significant. Also, since the claims are not limited to particular amounts of microcapsules and binder, it would be helpful to show that the amounts of each does not matter in that the inventive fabric will always have more microcapsules and greater penetration of microcapsules than the prior art fabric.

6. Applicant argues that Kamata et al does not disclose how the textile material takes up the microcapsules or how they are distributed within the textile, i.e., between the fibers, on the layers, etc. However, the instant claims do not recite where the microcapsules are other than to say they are distributed around and through the textile material. Since in Kamata the textile takes up all the microcapsules, it is reasonable to

Art Unit: 1771

presume that the microcapsules would be found both within and on the surface of the fabric.


7. Applicant's discussion of the advisory action and the amendment to claim 44 have clarified the order of steps. However, the Declaration is not sufficient to overcome the rejection for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.


Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c